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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER ROBERT FOLEY
and HOWARD DAVID HUTTON

Appeal 2008-5694
Application 09/909,288
Technology Center 1700

Oral Hearing Held: Thursday, January 15, 2009

Before BRADLEY R. GARRIS, MICHAEL P. COLAIANNI, and JEFFREY B. ROBERTSON, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

MR. MCKELVEY, ESQUIRE

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1 The above-entitled matter came on for hearing on Thursday,
2 January 15, 2009, commencing at 10:02 a.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before
4 Ashorethea Cleveland, Notary Public.

5 THE USHER: Calendar Item 33, Mr. McKelvey.

6 JUDGE GARRIS: Good morning, sir. Did I understand your
7 name to be Mr. McKelvey?

8 MR. McKELVEY: No relationship. I've gotten that before.
9 I'm sure he looks just like me.

10 JUDGE GARRIS: Sir, as you know, you have about 20
11 minutes to present your case. Please begin.

12 MR. McKELVEY: Thank you. May it please the Board.
13 Well, this case is pretty extensive. It's about eight years old since the
14 original filing. So, without going into detail into the facts, I'd like to jump
15 straight into the primary issue of the case which is whether a Markush group
16 in a secondary reference can imply or result in a decision that would indicate
17 that there's some equivalence among the members of the Markush group.
18 The Examiner in this case would argue yes but we haven't been able to find
19 any authority, in either case law or in the MPEP to suggest that there would
20 be any such equivalence.

21 The Examiner relies on a case, *In re Fout*, but I believe so
22 improperly. *Fout* really doesn't even address Markush groupings at all. If
23 you run a search of the text of the opinion, you can't find the word
24 "Markush" in it.

25 It really is being used by analogy whether the Jepson styled
26 claim being used in combination with a secondary reference to determine

1 whether there's some equivalence between the two methods that are
2 described in those cases.

3 So, by analogy, I wouldn't want to project any relevance really
4 between Fout and a decision which would affect how you would determine
5 equivalence in a Markush group.

6 So, without even going into the case law, I think you can look
7 directly at MPEP, Section 2144.06 which states that in order to rely on
8 equivalence as a rationale supporting an obviousness rejection the
9 equivalency must be recognized in the art and not the mere fact that the
10 components at issue are functional or mechanical equivalence.

11 You also have to keep in mind that the Examiner's primary
12 argument is that the Markush group creates functional equivalency and not
13 any other kind of substance equivalency among the members of the group.

14 JUDGE ROBERTSON: Mr. McKelvey.

15 MR. McKELVEY: Yes, sir.

16 JUDGE ROBERTSON: Can I interrupt you for a moment?
17 Could you point to me in the Examiner's rejection where he relies on the
18 Markush group?

19 MR. McKELVEY: Sir, if I can pull out the file, I can pull it out
20 for you.

21 JUDGE ROBERTSON: Or as an alternative, can you point out
22 in the references?

23 MR. McKELVEY: Well, in his reply brief, if you take a look
24 in primary argument, in his response to our arguments, the Examiner cites In
25 re Fout at the end of his statements saying that a Markush grouping of that
26 kind does imply equivalency among the members of the group.

1 JUDGE ROBERTSON: Yes; but that seems to be in response
2 to your argument that the Examiner has relied on a Markush group; and I'm
3 trying to identify the Markush group on which the Examiner relies.

4 In his rejection, the Examiner seems to state that the references
5 teach that the materials are equivalent but does not specifically say in the
6 rejection that there are Markush groups --

7 MR. McKELVEY: All right. I do have a citation of the
8 rejection here. I have to flip through. I'm sorry. The Examiner says
9 specifically -- I'm sorry I don't have a specific reference but he says actually:

10 "In the cleaning and detergent field the listing of several
11 components in a Markush group useful in the composition as thickeners or
12 solvents for example does create a presumption that these materials are
13 equivalent thickening or solvent materials."

14 "Further one of ordinary skill in the art looking at such
15 reference will recognize these materials are equivalent for their disclosed
16 intended use within such a composition. It is not necessary that the prior art
17 specifically states that these materials are equivalence and the equivalency is
18 implicit since these materials are always together --" Et cetera.

19 So, that was the Examiner's statement.

20 JUDGE ROBERTSON: But that statement is in response to
21 your characterization of references as teaching Markush groups; and I'm
22 trying to find in the references where there's a Markush group. I don't see
23 the "selected from the group consisting of" language that normally identifies
24 Markush groups.

25 MR. McKELVEY: Right. Well, the language used in the
26 argument is a Markush group; but in the reference itself, in column six, lines

1 60 through -- well, the end of the page -- creates this grouping where it says,
2 "Common thickeners such as polyacrylic, xanthin and gums, carboxylic
3 methylcellulose as well as Smectite clays and the like can be used herein."

4 JUDGE ROBERTSON: That's what I'm saying. Where is the
5 Markush group language in that, in that language?

6 MR. McKELVEY: I guess by form I wouldn't call it
7 necessarily Markush language in the text of the specification.

8 (Pause.)

9 MR. McKELVEY: I'm sorry. I'm failing to find it myself at
10 this stage but even without Markush language *per se* being used and
11 "selected from a group consisting of" a grouping here, it's still analogous to
12 Markush language and doesn't otherwise teach equivalence among the
13 members of that group.

14 JUDGE ROBERTSON: Now, you cite *In re Ruff* in response?

15 MR. McKELVEY: Yes.

16 JUDGE ROBERTSON: Can you tell me how that case is
17 applicable to the present situation? Here we have components disclosed in a
18 prior art reference.

19 MR. McKELVEY: Yes.

20 JUDGE ROBERTSON: The Markush group in *Ruff* was in a
21 claimed invention. So, how is that relevant in this case?

22 MR. McKELVEY: Well, it's still a relevance, I would assert,
23 because *In re Ruff* still holds to the standard that you must show some kind
24 of an affirmative equivalency taught in the prior art reference in order for
25 equivalency to be established.

1 So, just reciting a number of ingredients, whether it's a laundry
2 list or short list of ingredients, In re Ruff still shows that you have to hold
3 true to the MPEP standard of showing equivalency affirmatively in the prior
4 art.

5 JUDGE ROBERTSON: And your position is the Culshaw's
6 disclosure in column six that states "common thickeners such as" and lists
7 those thickeners, including Smectite clays, that's not an art-recognized
8 equivalence?

9 MR. McKELVEY: Well, it doesn't necessarily show that they
10 are interchangeable. You can use lots of ingredients as functional thickeners
11 but it doesn't mean you can substitute one for the other and still end up with
12 the same results. There's no teaching affirmatively there that would show
13 that; and I believe that that's actually what's addressed in the MPEP section,
14 which is 2144.06.

15 Again, this section says that the mere fact that components
16 claimed as members of a Markush group -- we can put the Markush
17 language aside. It still says it cannot be relied upon to establish equivalency
18 of those components; and the example used in the reference says that the
19 mere fact that phthalocyanine and selenium function as equivalent photo
20 conductors of the claimed invention is not sufficient to establish that one
21 would have been obvious over the other.

22 So, those again would have the functional equivalency of photo
23 conductors but it doesn't necessarily mean according to the patent manual
24 that they would be interchangeable ingredients.

25 JUDGE GARRIS: Sir, why don't you go ahead and finish out
26 your presentation if there is anything else you care to present.

1 MR. McKELVEY: That's where we come out on this issue.

2 JUDGE GARRIS: Let me ask Judge Colaianni if he has any
3 questions.

4 JUDGE COLAIANNI: No questions.

5 JUDGE GARRIS: Judge Robertson?

6 JUDGE ROBERTSON: No questions.

7 JUDGE GARRIS: I think that does it for today.

8 MR. McKELVEY: Okay. Well, thank you very much for your
9 time.

10 JUDGE GARRIS: Thank you, Mr. McKelvey.

11 Whereupon, at approximately 10:14 a.m., the proceedings were
12 concluded.